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***Groups I and II – Subcombination Usable Together (OA, pgs. 1&2)***

The Examiner alleges that groups I and II correspond to subcombinations usable together (MPEP §806.05(d)). However, claims 1 and 34 (Groups I and II) recite “a first staging area comprising a first staging surface and a first stage transport assembly; a second staging area generally disposed downstream from the first staging area, the second staging area comprising a second staging surface and a second stage transport assembly.” Claim 1 recites further “a third staging area...; and a conveying device adjustable between flats mode and a letter mode, wherein: in the letters mode position, a first material flow path is defined...; and in the flats mode path, the first material flow path is defined...” Claim 34 recites further “an adjustable transport assembly comprising a lower transport assembly adjustable between a flats mode position and a letters mode position...”

Based on the recited claim language, the Examiner should have made a restriction requirement under combination/subcombination (See MPEP §806.05(c)), and not subcombination usable together. Subcombinations usable together would be proper if the claim groups recited entirely different elements which are usable together. However, this does not apply.

In order to establish that combination/subcombination inventions are distinct, two-way distinctness *must* be demonstrated. (See MPEP §806.05(c)). The Examiner alleged that invention I separate utility such as utilizing a 3rd staging area and invention II has separate utility such as utilizing rotatable elements. However, combination/subcombination also requires a showing that a combination as claimed (1) does not require the particulars of the subcombination as claimed for patentability; AND (2) the subcombination can be shown to have utility either by itself or in other and different relations.

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Even assuming that restriction was properly based, the Examiner does not provide a meaningful explanation of separate utility. The explanation of alleged separate utility simply argues that each of the two groups has separate utility because each does not require elements of the other, that is to say each group included different limitations. Citation of different claim limitations, however, does not meet the burden of showing a factual basis for the allegations of separate utility necessary to justify the restriction requirement. Should this be the case, every claim would be restricted.

The Examiner has failed to establish a *prima facie* case of restriction between Groups I and II.

***Groups III and II – Combination/Subcombination (OA, pg. 2 & pg. 3)***

On page 2, the Examiner alleged that the combination does not require a 3rd staging area, and on page 3, the Examiner alleged that the combination does not require rotatable elements. In each case, the Examiner alleged that the subcombination has separate utility such as operating without an upstream device.

Combination/subcombination require a showing that a combination as claimed (1) does not require the particulars of the subcombination as claimed for patentability; AND (2) the subcombination can be shown to have utility either by itself or in other and different relations. However, the fact that the subcombination may operate *without* an element such as an upstream device found in the combination does not establish separate utility. The Examiner must allege some other purpose with which the subcombination itself *as claimed* would have separate utility.

The Examiner has failed to establish a *prima facie* case of restriction between Groups III and II.

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***Groups IV and I – Process/Apparatus (OA, pg. 2)***

The Examiner states that the "apparatus could be operated without moving an adjustable conveying element, achieving re-routing via an air-jet diverter or a one-way passive diverter." The mere recitation that the apparatus can be practiced *without moving the adjustable conveying element* (*i.e.*, a stationary element) does not correspond to the language of claim 1. Claim 1 explicitly recites a "conveying device *adjustable* between a flats mode position and a letters mode position" and continues on to recite material flow path in each position. The Examiner must consider the claim language at issue and is not permitted to change claim language to fit an alleged material difference. In fact, the MPEP requires that the Examiner consider whether "the apparatus *as claimed* can be used to practice another and material different process." In other words, the Examiner must consider whether the conveying device *adjustable* between a flats mode position and a letters mode position could be used to practice another and material different process, not whether the apparatus can be modified other than as claimed to accommodate another and materially different process. (*Emphasis Added*).

The Examiner has failed to establish a *prima facie* case of restriction between Groups IV and I.

***Groups V and I – Process/Apparatus (OA, pgs. 3 & 4)***

As regards Group IV, the Examiner states that "the method can be used to transport stacks." Whether or not the method can be used in this manner is irrelevant. Rather, the Examiner is required to show that "the process *as claimed* can be practiced by another materially different *apparatus* or by hand." The Examiner has not shown "another materially different apparatus" that may be used for the process claimed.

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Also, the Examiner states that the apparatus "can be used in an environment with *no moving of an adjustable element*." Following the Examiner's rationale, if the adjustable element was not adjustable, *i.e.*, it was stationary, it would not correspond to the claims of group I. As we stated above, the MPEP requires that the Examiner consider whether "the apparatus *as claimed* can be used to practice another and material different process." In other words, the Examiner must consider whether the conveying device *adjustable* between a flats mode position and a letters mode position could be used to practice another and material different process, not whether the apparatus can be modified (e.g. making the claimed adjustable element stationary) other than as claimed.

The Examiner has failed to establish a *prima facie* case of restriction between Groups V and I.

***Groups III and II – Combination/Subcombination (OA, pg. 4)***

On page 4, the Examiner alleged that the combination does not require rotatable elements, and that the subcombination has separate utility such as operating without an upstream device.

Combination/subcombination require a showing that a combination as claimed (1) does not require the particulars of the subcombination as claimed for patentability; AND (2) the subcombination can be shown to have utility either by itself or in other and different relations. However, the fact that the subcombination may operate *without* an element such as an upstream device found in the combination does not establish separate utility. The Examiner must allege some other purpose with which the subcombination itself *as claimed* would have separate utility.

The Examiner has failed to establish a *prima facie* case of restriction between Groups III and II.

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***Groups IV and III and Groups V and III – Process/Apparatus (OA, pg. 5)***

The Examiner asserts that “the process can be practiced by an apparatus *without* an upstream processing device,” and that “the apparatus can be used to practice a process *with no* 3rd staging area.” Applicants direct the Examiner’s attention to MPEP Section § 806.05(e), which states that “[t]he burden is on the Examiner to provide *reasonable examples that recite material differences*.” The fact that the process can be practiced without an element of the apparatus does not show any material difference. To put it another way, should the Examiner conduct a prior art search on the apparatus, prior art with or without an upstream processing device would read on the process. There would be no undue burden on the Examiner.

Moreover, the Examiner is required to show that “the apparatus as claimed can be used to practice another and materially different process.” The fact that the apparatus may be used to practice “a process with no 3rd staging area” is irrelevant. The Examiner has failed to identify another and materially different process.

The Examiner has failed to establish a *prima facie* case of restriction between Groups IV and III and between Groups V and III.

***Groups IV and II and Groups V and II – Process/Apparatus (OA, pgs. 4 & 5)***

The Examiner asserts that “the process can be practiced by an apparatus *without* a rotatable element,” and that “the apparatus can be used to practice a process *with no* 3rd staging area.” Applicants again direct the Examiner’s attention to MPEP Section § 806.05(e), which states that “[t]he burden is on the Examiner to provide *reasonable examples that recite material differences*.” The fact that the process can be practiced without an element of the apparatus does not show any material difference. To put it another way, should the Examiner conduct a prior art

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search on the apparatus, prior art with or without a rotatable would read on the process. There would be no undue burden on the Examiner.

Moreover, the Examiner is required to show that "the apparatus as claimed can be used to practice another and materially different process." The fact that the apparatus may be used to practice "a process with no 3rd staging area" is irrelevant. The Examiner has failed to identify another and materially different process.

The Examiner has failed to establish a *prima facie* case of restriction between Groups IV and II and between Groups V and II.

***Groups IV and V – Subcombination Disclosed as Usable Together (OA, pgs. 5 & 6)***

The Examiner asserts that invention IV has separate utility such as sending flats to a 3rd staging area, and invention V has separate utility such as transporting stacks.

Applicants direct the Examiner's attention to the claim language at issue. Claim 51 (Group IV) and Claim 61 (Group V) each recite providing a collector apparatus including a first, second and third staging area. Claim 51 also recites moving an adjustable conveying element whereas Claim 61 recites setting an adjustable conveying element to a position.

Subcombinations usable together would be proper if the claim groups recited entirely different elements which are usable together. However, this does not apply. At least based on the grouping of the claims and because claims 51 and 61 similarly recite elements, subcombination usable together theory is improper. Moreover, citation of similar but different claim limitations does not meet the burden of showing a factual basis for the allegations of separate utility necessary to justify the restriction requirement. Should this be the case, every claim would be restricted.

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The Examiner has failed to establish a *prima facie* case of restriction between Groups IV and V.

***Groups VI and I – Process/Apparatus (OA, pg. 6)***

The Examiner states that the process “does not require an apparatus without a rotatable element,” and that the apparatus “can be used in a method wherein flats are not sent to a 3rd staging area.”

However, the fact that the process may be practiced without an element of the apparatus does not show any material difference. To put it another way, should the Examiner conduct a prior art search on the apparatus, prior art with or without a rotatable would read on the process. There would be no undue burden on the Examiner.

Moreover, the Examiner is required to show that “the apparatus as claimed can be used to practice another and materially different process.” The fact that the apparatus may be used to practice “a method wherein flats are not sent to a 3rd staging area” is irrelevant. Citation of different claim limitations does not meet the burden of showing a factual basis for the allegations of separate utility necessary to justify the restriction requirement. Should this be the case, every claim would be restricted.

The Examiner has failed to establish a *prima facie* case of restriction between Groups VI and I.

***Groups VI and II – Process/Apparatus (OA, pg. 6)***

The Examiner states that the process can be practiced without a rotatable element and that the apparatus can be used in a method wherein flats are not sent to a 3rd staging area.

However, the fact that the process may be practiced without an element of the apparatus does not show any material difference. To put it another way, should the Examiner conduct a

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prior art search on the apparatus, prior art with or without a rotatable would read on the process.

There would be no undue burden on the Examiner.

Moreover, the Examiner is required to show that "the apparatus as claimed can be used to practice another and materially different process." The fact that the apparatus may be used to practice "a method wherein flats are not sent to a 3rd staging area" is irrelevant. Applicants emphasize that citation of different claim limitations does not meet the burden of showing a factual basis for the allegations of separate utility necessary to justify the restriction requirement. Should this be the case, every claim would be restricted.

The Examiner has failed to establish a *prima facie* case of restriction between Groups VI and II.

***Groups VI and III – Process Apparatus (OA, pg. 6)***

The Examiner states that "the process can be practiced by an apparatus which does not have a upstream processing," and that the "apparatus can be used to practice a process that has no provision for transporting stacks."

As MPEP Section § 806.05(e) provides, "[t]he burden is on the Examiner to provide *reasonable examples that recite material differences*." The fact that the process can be practiced without an element of the apparatus does not show any material difference. To put it another way, should the Examiner conduct a prior art search on the apparatus, prior art with or without upstream processing would read on the process. There would be no undue burden on the Examiner.

Moreover, the Examiner is required to show that "the apparatus as claimed can be used to practice another and materially different process." The fact that the apparatus may be used to practice "a process that has no provision for transporting stacks" is irrelevant. Neither claim



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group recites the transportation of stacks. Rather, the claimed apparatus is adjustable between a flats and letters mode for transporting such material. The Examiner is required to review the claims *as claimed*. The Examiner has failed to identify another and materially different process.

The Examiner has failed to establish a *prima facie* case of restriction between Groups VI and III.

***Groups VI and IV – Subcombinations Usable Together (OA, pg. 7)***

The Examiner states that invention VI has separate utility such as sending letters to a 1st staging area, and invention IV has separate utility transporting stacks. However, subcombination usable together theory requires a showing of one-way distinctness. The Examiner must establish that one of the subcombinations has utility other than in the disclosed combination. Yet, the Examiner merely recites elements of the claims, and has not provided any evidence of utility for another use. Citation of different claim limitations does not meet the burden of showing a factual basis for the allegations of separate utility necessary to justify the restriction requirement. Should this be the case, every claim would be restricted.

The Examiner has failed to establish a *prima facie* case of restriction between Groups VI and IV.

***Groups VI and V – Subcombination Usable Together (OA, pg. 7)***

The Examiner states that invention V has separate utility such as sending letters to a 1st staging area, and invention VI has separate utility such as sending flats to a 3rd staging area. However, as stated above, subcombination usable together theory requires a showing of one-way distinctness. The Examiner must establish that one of the subcombinations has utility other than in the disclosed combination. Here, the Examiner merely recites elements of the claims, and has not provided any evidence of utility for another use. Citation of different claim limitations does

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not meet the burden of showing a factual basis for the allegations of separate utility necessary to justify the restriction requirement. Should this be the case, every claim would be restricted.

The Examiner has failed to establish a *prima facie* case of restriction between Groups VI and V.

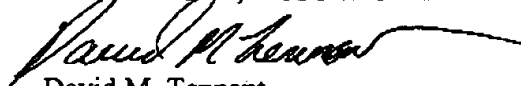
**Conclusion**

Applicants request prompt reconsideration and examination of all of the originally pending claims in this one case. It is further noted that if "the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent and distinct inventions." (See MPEP §803).

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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